

## REMARKS

Claims 13-31 stand rejected under 35 USC §101 as not being appropriately directed to statutory subject matter. Claims 13, 16, 25 and 30 stand rejected under 35 USC §112, second paragraph as not being sufficiently definite. Claims 13, 15-16, 22-25, 27 and 30-31 stand rejected under 35 USC §102(b) as being anticipated by US patent application publication No. 2004/0203580 (hereinafter Engelhart). Claim 14 stands rejected under 35 USC §103(a) as being unpatentable over Engelhart. Claims 17-19, 21, 26 and 28-29 stand rejected under 35 USC §103(a) as being unpatentable over Engelhart in view of US patent application publication No. 2003/0182413 (hereinafter Allen). Claim 20 stands rejected under 35 USC §103(a) as being unpatentable over Engelhart in view of Allen and further in view of US patent application publication No. 2002/0023033 (hereinafter Campbell). Claims 19, 20 and 28 stand objected to in view of certain informalities noted in the Office Communication. Applicant respectfully requests reconsideration of the rejections and objections in view of the foregoing amendments and the following remarks.

Claims 1-12 were previously canceled. Claims 16, 17 and 26-28 are presently cancelled. Thus, claims 13-15, 18-25 and 29-31 are presented for examination.

The informalities noted in the Office Communication have been corrected. Accordingly, the objections to the claims should be withdrawn.

### 35 U.S.C. 101 rejections

MPEP 2107 (Examination Guidelines For The Utility Requirement) instructs Examiners that if the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility. MPEP 2107 further instructs that Office personnel are reminded that they must treat as true a statement of fact made by an applicant in relation to an asserted utility, unless countervailing evidence can be provided that shows that one of ordinary skill in the art would have a legitimate basis to doubt the credibility of such a statement.

In the present application, one skilled in the art would recognize that the claimed invention has a practical purpose for consumers of radio communication services conducive to

facilitating a selection of service providers based on the value of a selection parameter. In view of the foregoing considerations and consistent with the MPEP guidelines, the claimed invention meets the specific and substantial utility requirements and this basis of rejection under §101 should be withdrawn.

35 U.S.C. 112, second paragraph rejections

Per MPEP 2173.02, when determining compliance with the requirement of definiteness of 35 USC 112, second paragraph, the Examiner is required to assess whether the claim meets the threshold requirement of clarity and precision, and not whether more suitable language or modes of expression are available. Applicant has amended claims 13, 16, 25 and 30 essentially as suggested by the Examiner. Accordingly, these claims appropriately meet the threshold requirements of clarity and precision under 35 U.S.C. 112, second paragraph and therefore this basis of rejection should be withdrawn.

35 U.S.C. 102 rejections

MPEP §2131 provides that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. The identical invention must be shown in as complete detail as contained in the claim. The elements must be arranged as required by the claim.

Claim 13 is directed to a computerized method for selecting a provider that provides a radio communication service that can be received by a mobile station via a radio access network. Claim 13 in part recites that in the event the received new values of at least two providers have identical values, the selecting is performed on a random basis. Basis for the foregoing amendment may be found at least in paragraphs 20 and 43 of the US patent application publication of the present invention. Engelhart nowhere describes or suggests any selecting being performed on a random basis. Anticipation under 35 U.S.C. §102 requires that "The identical invention must be shown in as complete detail as contained in the ...claim." (Citations omitted). In view of the foregoing considerations, Engelhart fails as an anticipatory reference since Engelhart fails to describe each and every element and/or operational relationship as set forth in the claimed invention. Thus,

anticipation under 35 U.S.C. §102 is not supported by the applied reference and the rejection of claim 13 should be withdrawn.

Claim 25 is directed to computerized selecting device for selecting a provider for a radio communication service that can be received by a mobile station via a radio access network. Claim 25 in part recites that in the event the received new values of at least two providers have identical values, the selector is configured to select a provider on a random basis. As noted above, Engelhart fails as an anticipatory reference since Engelhart fails to describe each and every element and/or operational relationship as set forth in the claimed invention. Thus, anticipation under 35 U.S.C. §102 is not supported by the applied reference and the rejection of claim 25 should be similarly withdrawn.

#### 35 U.S.C. 103 rejections

M.P.E.P. 2143.03 provides that to establish *prima facie* obviousness of a claimed invention, all the claims limitations must be taught or suggested by the prior art. All words in a claim must be considered for judging the patentability of the claim against the prior art. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending there from is nonobvious.

It is noted that none of the applied art remedies the deficiencies of Engelhart noted above regarding the claimed invention. Accordingly, Engelhart alone (and in combination with any of the applied secondary references) fails to teach or suggest each of the structural and/or operational relationships set forth in the claimed invention. Consequently, Engelhart (alone and in combination with the applied secondary references) also is not an appropriate reference (or combination of references) for sustaining a rejection of the claimed invention (including claims respectively depending from independent claims 13 and 25) under the §103 statutory requirements and this basis of rejection should be withdrawn.


Conclusion

It is respectfully submitted that each of the claims pending in this application recites patentable subject matter and it is further submitted that such claims comply with all statutory requirements and thus each of such claims should be allowed.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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